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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Martin HEENEY et al.

Group Art Unit 1711

Serial No.: 10/661,812

Examiner: Duc Truong

Filed: September 15, 2003

For: MONO-, OLIGO- AND POLY(3-ALKYNYLTHIOPHENES) AND THEIR USE AS CHARGE TRANSPORT MATERIALS

**RESPONSE TO REQUIREMENT FOR RESTRICTION
AND ELECTION OF SPECIES**

MAIL STOP AMENDMENT
Commissioner for Patents
Box 1450
Alexandria, Virginia 22313-1450

SIR:

This is in response to the Office Action mailed July 8, 2005. The undersigned counsel notes that he made a telephonic election pursuant to a restriction and election of species requirement of the Examiner back on February 28, 2005. In this action, the restriction requirement is the same but the election of species requirement is changed.

In response to the restriction requirement, applicants hereby elect Group I, claims 1-15, drawn to monomers, oligomers and polymers. The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.


The restriction of Group II, claims 16-27, from Group I, claims 1-15, does not meet the requirements for restriction between subcombination/combination set forth in MPEP §806.05(c). The non-elected claims 16-27 are directed to compositions, polymers, etc., which contain or are

derived from a monomer, oligomer, or polymer of claims 1-15, and some other component. Thus, the combination in this subcombination/combination relationship is the subject matter of claims 16-27, not the subject matter of claims 1-15. In other words, the compositions, etc., of claims 16-27 combine the monomer, oligomer, polymer aspect of claims 1-15 with another component. Thus, claims 16-27 are clearly the combination in the relationship. In view of this correct identification of the claims' relationship, it should be evident that the combination, as claimed, does require the particulars of the subcombination. Each of claims 16-27 require the particulars of the subcombination claims 1-15. Each of claims 16-27 ultimately depends upon claim 1, thus, by definition as dependent claims, they must require the particulars of claim 1. To put it another way, if claim 1 is allowable, claims 16-27 should also be allowable because they contain an embodiment of claim 1 as a component. Accordingly, since the first prong of the basis for restriction under MPEP §806.05(c), recited in the Office Action, is not met, the restriction requirement herein is not supported. No other basis for restriction is apparent, thus, the requirement should be withdrawn.

In response to the Election of Species requirement, applicants hereby elect formula Ia of claim 14. The Examiner is encouraged to examine the broadest possible scope of invention indicated by the elected species. In accordance with M.P.E.P. §803.02, the Examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. It is improper for the PTO to refuse to examine in one application the entire scope of the claims therein unless they lack unity of invention. The generic claims herein have not been alleged to lack unity of invention.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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